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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID L. BAHR, DOUGLAS W. BAHR,
MEENAL V. EKBOTE, and ALEXANDRE OKONECHNIKOV

Appeal 2009-005331
Application 09/497,383
Technology Center 2400

Decided: January 5, 2010

Before MAHSHID D. SAADAT, CARLA M. KRIVAK, and
CARL W. WHITEHEAD, JR., *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1-16, 18-27, 29-33, 35-53, and 55-75. Claims 17, 28, 34, 54, and 76 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

STATEMENT OF THE CASE

Appellants' invention relates to document scanning, converting a document from printed form to electronic form, and storing the document data files in a database (Spec. 1). According to Appellants, the invention further facilitates transmission of data between client devices and servers coupled by one or more networks, wherein the scanned document is displayed to be accessible to the public or to users with security privileges via the Internet (*id.*).

Independent Claim 1 is illustrative of the invention and reads as follows:

1. A method comprising the step of:
 - a) generating a display based on a hypertext mark-up language (HTML) document stored in a client device using a web browser of a user interface of the client device, the display including a document display portion, an index field portion, and a control portion all visibly defined in the display in separate portions thereof by the HTML document, the document display portion including a display of document data received from a scanner coupled to the client device, the scanner generating the document data by scanning a document in print form, the document data representing the scanned document, the index field portion permitting index data to be input by a user with an input device of the client device into the user interface in association with the document data, and the control portion including at least one control element operable by the user with the input device for generating a start scan signal to initiate scanning of the document with

the scanner to generate the document data and for generating a send data signal to transmit the document data with the index data displayed by the web browser from the client device to the server over a network using a destination address for the server specified in an address field of the web browser.

The Examiner relies on the “Quillix Data Sheet” document (hereinafter “Quillix 1”) which is in the form of a press release dated January 18, 2000, by Prevalent Software, Inc. titled “*Prevalent Software Inc. Introduces Quillix,*” cited by Appellants in a response filed May 7, 2004. Claims 1, 3-16, 18-22, 24-27, 29-33, 35-53, 55-62, and 64-75 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Quillix 1, while claims 2, 23, and 63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Quillix 1.¹

Rather than repeat the arguments here, we make reference to the Briefs and the Answer for the respective positions of Appellants and the Examiner.

ISSUE

The issue is whether the Examiner erred in rejecting the claims under 35 U.S.C. §§ 102(e) and 103(a). The issue specifically turns on whether Quillix 2 qualifies as prior art and, if not, whether Quillix 1 alone anticipates Appellants’ claimed invention by disclosing all the claimed features.

¹ In rejecting the claims, the Examiner further relies (Ans. 4) on the content and the figure from a different Quillix document titled “*The Web Made Distributed Data Management Possible, Quillix Makes it Practical,*” (hereinafter “Quillix 2”) printed March 28, 2000, which is after the filing date of Appellants’ application on February 3, 2000.

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992)); *see also In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994). “Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (quoting *Titanium Metals Corp. of Am. v. Banner*, 778 F.2d 775, 781 (Fed. Cir. 1985)).

ANALYSIS

The Examiner relies on Quillix 1 (released Jan. 18, 2000) for teaching all the claimed limitations mainly based on Appellants’ statement that “Quillix [1] appears to contain similar or the same functionality as the claimed invention” (Ans. 3-4). Specifically, the Examiner identifies several elements in Quillix 2 (printed Mar. 28, 2000) and asserts that this document, which has a later publication date than the application filing date, discloses all the elements recited in claim 1 (Ans. 4-5). Similarly, the Examiner reads the recited features of other independent claims on the elements disclosed in Quillix 2 (Ans. 7-15).

Appellants argue (App. Br. 7) that the Examiner relied on Quillix 2, bearing a print date of March 28, 2000, while Quillix 1, dated January 18, 2000, was also mentioned by the Examiner. Appellants further refer to their statement made in the amendment filed May 7, 2004, and assert that merely

mentioning that “Quillix [1] appears to contain similar or the same functionality as the claimed invention” is not an admission that Quillix 1 is “prior art” (App. Br. 7-8). Appellants argue that Quillix 1 is the best source to determine what Quillix 1 teaches and, based on its own disclosure, does not disclose the same invention recited in Appellants’ claims (App. Br. 8-9).

We find two problems with the Examiner’s position. First, Appellants’ acknowledgement that Quillix 1 appears to contain similar or the same functionality as the claimed invention does not mean that Quillix 1 discloses all the claimed features. Appellants’ statement merely recognizes Quillix 1 as a related document disclosing a system that includes similar or the same functionalities, but is not an admission that all their claim features are disclosed in Quillix 1. Even if Quillix 1 is properly applied as prior art in rejecting the claims, the Examiner must show all the claimed elements in the reference. Instead, the Examiner refers to a figure and certain elements from another document, Quillix 2.

The second problem with the Examiner’s position stems from reading the claim features on the elements disclosed in Quillix 2. In other words, the Examiner had to rely on another document, which was published after the filing date of Appellants’ application, to show all the claimed elements (Ans. 4).

As such, we agree with Appellants (App. Br. 9) that the statement identifying Quillix 1 as prior art cannot be interpreted in a manner contrary to the content of the document. In that regard, since Quillix 1 does not disclose all the recited features of claim 1 and Quillix 2, which was relied on by the Examiner to provide teachings that were not included in Quillix 1, has a publication date after the filing date of Appellants’ application, we find

that the applied prior art does not disclose all the claimed limitations and cannot anticipate the claimed subject matter.

CONCLUSION

On the record before us, we find that Appellants have shown that the Examiner erred in rejecting the claims since Quillix 2 cannot be properly relied on as prior art and Quillix 1 alone fails to disclose all the claimed features. Therefore, in view of our analysis above, the 35 U.S.C. § 102 rejection of claims 1, 3-16, 18-22, 24-27, 29-33, 35-53, 55-62, and 64-75 cannot be sustained. Additionally, we do not sustain the 35 U.S.C. § 103 rejection of claims 2, 23, and 63 since the Examiner has not identified any modifications to the prior art to overcome the deficiencies of Quillix 1 discussed above.

DECISION

The decision of the Examiner rejecting claims 1-16, 18-27, 29-33, 35-53, and 55-75 is reversed.

REVERSED

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